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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/035,335  | 01/04/2002  | Ian R. Ameline       | 1260.00             | 2226             |
| 26111   | 7590        | 03/24/2006           | EXAMINER            |                  |
| STERNE, KESSLER, GOLDSTEIN & FOX PLLC<br>1100 NEW YORK AVENUE, N.W.<br>WASHINGTON, DC 20005 |             |                      | BAYAT, ALI          |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2624                |                  |

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/035,335             | AMELINE ET AL.      |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Ali Bayat              | 2627                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 19, 21-24, 36 and 45-47 is/are rejected.
- 7) ☒ Claim(s) 3-18, 20, 25-35 and 37-44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 19, 21, 22, 23-24 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Levy ( Pub. No.: US 2003/0112974).

In regard to claim 1, Levy provides for generating, for each of the output images, the digital watermark (Fig.2 element 102, para. 26), the digital watermark having at least one attribute (Para.27 see message symbols), wherein each attribute is a function of a variable associated with the attribute (Para.26, note mapping key and carrier key is a pseudorandom number that acts as a carrier signal for the message payload), the variable being capable of modification from image to image to produce a different digital watermark on each of the output images ; and applying the digital watermark to each output image to produce corresponding watermarked images ( Para.40)

With regard to claims 2 and 24 Levy provides for a method , wherein the generating step comprises: generating, for each of the output images, the digital watermark, wherein said at least one attribute of the digital watermark is a function of a random number ( Para.40).

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As to claims 19 and 36, Levy provides for repeating generating and applying steps a plurality of times for each output image (see last part of Para. 40).

In regard to claim 21, Levy provides for applying said watermark to a substantial portion of the said output images to produce corresponding watermarked images (see Para. 26).

With regard to claim 22, Levy provides for ensuring that there is overlap from image to image in the watermarked portions of said watermarked images (see Para. 34).

AS to claim 23, see the rejection of claim 1. It recites similar limitation as claim 1. Except for a computer program product (see Para. 64). Hence it is similarly analyzed and rejected.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy (US 2003/0112974) in view of Kanevsky et al. (US 2002/0107750).

In regard to claim 45, Levy provides for a method, for producing a commercial version of the computer program, said commercial version of the computer program having a first output file format (Fig.2 element 102, para. 26, also see Para.64); the prior

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art of Levy does provide for a non-commercial version of the computer program, said non-commercial version having a second output file format that cannot be read by said commercial version of the computer program, and wherein the output images produced by said non-commercial version of the computer program are watermarked with a visible watermark. Kanevsky provide for limitation above (Para. 18 note trial or demonstration version or sample, further note element 9) unpleasant visual and auditory stimulus is produced). The prior art of Levy and Kanevsky are combinable because they are from the same field of endeavor (watermarking). At time the invention was made, it would have been obvious to a person of ordinary skill to incorporate the teaching of Kanevsky with the system and method of Levy. Because the invention of Kanevsky relates to a system for encouraging users to purchase software applications after being provided with trial or demonstration versions of samples of the applications. See Para. 1.

With regard to claim 46-47. See the rejection of claim 45, note para. 18, further note element 9) unpleasant visual and auditory stimulus is produced).

### **Objected Claims**

3. Claims 3-18,20, 25-35 and 37-44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Bayat whose telephone number is 571-272-7444.

The examiner can normally be reached on M-F 9:00 AM-5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on 571-272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ali Bayat AB  
Patent Examiner  
Division 2624  
3/14/06

JINGGEWU  
PRIMARY EXAMINER

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